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10/804,616	03/19/2004	Alex J. Simmons	60001.0302US01/MS302497.1	7864
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MERCHANT & GOULD (MICROSOFT)			EXAMINER	
P.O. BOX 2903			SHAPIRO, LEONID	
MINNEAPOLIS, MN 55402-0903				
		ART UNIT	PAPER NUMBER	
		2629		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/804,616

**Applicant(s)**

SIMMONS, ALEX J.

**Examiner**

Leonid Shapiro

**Art Unit**

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 45-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 45-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

*Claim Rejections - 35 USC § 103*

*The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:*

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claim 45-53 rejected under 35 U.S.C. 103(a) as being unpatentable over Iwema et al. (US PGPub US2004/0021701 A1), in view of Lipton (5,757,383).

As to claims 45,48,51 Iwema et al. discloses a a computer-readable medium containing computer-executable instructions which when executed by a computer automatically adjust the electronic ink height, of an electronic highlighter device, comprising:

selecting an electronic pen for functioning as an electronic highlighter device (fig. 5, par. 0055);

engaging the electronic pen with a computer-displayed handwritten text selection (see FIGs. 5 and 10a and 10b) wherein determining the height of the computer-displayed handwritten text selection includes at least one member of a group (see FIG. 5) comprising; determining an average height of the computer-displayed handwritten text selection (see page 3 paragraph [0037] further see FIG. 5 describing vertical bounds at but not limited to page 5, paragraph [0055] further continued on page 6) without considering the length of any ascending or any descending character segment of any characters

comprising the computer-displayed handwritten text selection (see FIG. 5 further described at page 5, paragraph [0055]) and and setting the electronic ink height of the electronic pen to the determined height (see Iwema at page 5, paragraph [0055] further illustrated in FIG 5).

Iwema does not explicitly teach setting the electronic ink height of the electronic pen to the determined height wherein the set electronic ink height of the electronic pen is configured, to highlight the average height of the computer-displayed handwritten text selection without highlighting any ascending, or descending character segments of any characters comprising the computer-displayed handwritten text selection.

Lipton teaches setting automatically the ink height of the pen to the determined height wherein the set ink height of the electronic pen is configured, to highlight the average height of the computer-displayed handwritten text selection without highlighting any ascending, or descending character segments of any characters comprising the computer-displayed handwritten text selection (figs. 3-4, col. 5, lines 27-37).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize the electronic input device in the system of Iwema et al. with the selection methods of Lipton in order to increase legibility of selected typography (col. 1, lines 59-62 in the Lipton reference).

As to claims 47,50,53 Iwema et al. discloses the selecting an electronic pen for functioning as an electronic highlighter device includes selecting an

electronic mousing device for functioning as an electronic highlighter device (See Fig.5; page 6, paragraph 0056); and whereby engaging the electronic pen with a computer-displayed handwritten selection includes focusing a cursor of the electronic mousing device over the computer-displayed handwritten selection and clicking the electronic mousing device for distributing electronic ink onto the computer-displayed handwritten selection (See Fig.5; page 6, paragraph 0059).

As to claims 46,49,52 Iwema et al. teaches comprising distributing the electronic ink at the determined height onto the computer-displayed handwritten text selection (par 0055).

#### *Response to Arguments*

Applicant's arguments filed 02/18/09 have been fully considered but they are not persuasive:

On page 7, 1<sup>st</sup> paragraph of Remark, Applicant's stated that The Office Action fails to address the changes made in the Amendment After Final Rejection that was filed with the RCE dated November 3, 2008. In the Amendment entered with the RCE, the claims were amended to recite "in response to engaging the electronic pen with the computer-displayed handwritten text selection, automatically ...." In that this feature was not considered in the current Office Action, applicants assert that the next Office Action in this matter cannot be final.

However, the Office Action responded to amended claims by the newPrior Art (Lipton). Lipton teaches setting **automatically** the ink height of the pen to the

determined height wherein the set ink height of the electronic pen is configured, to highlight the average height of the computer-displayed handwritten text selection without highlighting any ascending, or descending character segments of any characters comprising the computer-displayed handwritten text selection (figs. 3-4, col. 5, lines 27-37).

On page 8, 1<sup>st</sup> paragraph of Remark, Applicant's stated that Iwema does not teach "in response to engaging the electronic pen with the computer-displayed handwritten text selection, automatically determining the height of the computer-displayed handwritten text selection, wherein determining the height of the computer-displayed handwritten text selection includes determining an average height of the computer-displayed handwritten text selection without considering the length of any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection," in combination with "setting the electronic ink height of the electronic pen to the determined height, wherein the set electronic ink height of the electronic pen is configured to highlight the average height of the computer-displayed handwritten text selection without highlighting any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection." Stated another way, Iwema does not teach the automatic determination response to the engagement of the electronic pen with the computer-displayed handwritten text selection. Furthermore, Iwema does not teach the determination of the height of the ink as indicated in independent claim 45. However, in response to applicant's arguments against the references individually, one cannot show

nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

On pages 8-9 paragraph of Remark, Applicant's stated that Lipton does not teach or otherwise suggest "in response to engaging the electronic pen with the computer-displayed handwritten text selection, automatically determining the height of the computer-displayed handwritten text selection, wherein determining the height of the computer-displayed handwritten text selection includes determining an average height of the computer-displayed handwritten text selection without considering the length of any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection," in combination with "setting the electronic ink height of the electronic pen to the determined height, wherein the set electronic ink height of the electronic pen is configured to highlight the average height of the computer-displayed handwritten text... However, Lipton teaches setting automatically the ink height of the pen to the determined height wherein the set ink height of the electronic pen is configured, to highlight the average height of the computer-displayed handwritten text selection without highlighting any ascending, or descending character segments of any characters comprising the computer-displayed handwritten text selection (figs. 3-4, col. 5, lines 27-37).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Telephone inquire***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leonid Shapiro whose telephone number is 571-272-7683. The examiner can normally be reached on 8 a.m. to 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe can be reached on 571-272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

04/13/09  
/L. S./  
Examiner, Art Unit 2629

/Richard Hjerpe/  
Supervisory Patent Examiner, Art Unit 2629